

REMARKS

The Office Action dated May 12, 2011 has been reviewed and carefully considered. New claim 20 has been added. Accordingly, claims 1-20 are now pending in the application. Claims 1, 10 and 20 are the only independent claims. Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks.

Claims 1, 2, 10, 11 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Brown et al. (US Pat. No. 7,085,818) in view of Mettu et al (SPPA 2004/0226043). Claims 3-8 and 12-17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Brown in view of Mettu as applied to claim 1, and further in view of further in view of O'Neil (US 2002/0107027). Claims 9 and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Brown in view of Mettu as applied to claims 1 and 10, and further in view of further in view of Smith (US Pat. No. 6,580,914).

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reason for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must

be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim as amended and with emphasis added, recites:

1. A method for providing user data pertaining to a user of a mobile terminal to a recommender system of a consumer electronic device, the method comprising the steps of:

determining, by the terminal, a current location of the terminal, wherein said current location is determined after receiving a initiating signal, said initiating signal being one of a user input and a received signal;

saving, in the terminal, an identifier of the determined location, based on a longevity of said terminal in an area proximate said current location; and

informing, by means of the terminal, said recommender system of the determined location;

wherein said **saving** step comprises determining a length of time for which the terminal stays in a region, and **said recommender system is arranged for proposing content related to said region only if the length of time is longer than a predetermined time period.**

The present invention relates to a user's mobile terminal saving identified locations when the user remains in those locations for a period of time that exceeds some threshold. A recommender system proposes content related to regions pertaining to those locations – that is, related to the locations which have been saved. Of significance is that the current invention, and the language of independent claims 1 and 10, requires the saving of the determined locations in the terminal. This permits a user traveling in

Barcelona Spain (as described in paragraph [0012] of published application) to have location(s) saved, and those locations are later transmitted to a recommender system via Bluetooth technology (paragraph [0010]).

As an initial matter, Applicant has amended claim 1 to recite that it is the saving step (that is, the saving of location information at the device) that further comprises “determining a length of time for which the terminal stays in a region.” Once these regions have been so determined and saved, as a consequence the recommender system is able to propose content related to these regions. That is, content related to a region will be presented only if the length of time in that region is longer than a predetermined time period. Support for this “only if” functionality is provided in the specification, inter alia, at paragraph [0019] which describes how a current region is not stored if the duration at that location is not met.

The Office Action relies on Brown as the primary reference against the claimed invention. Brown relates to a method and system for transmitting data to a wireless device in real time based on the device’s current location. As stated in his Abstract:

Provided is a method, system, and program for transmitting information to a wireless device. A determination is made of a current location of the wireless device and whether the current location is within a proximity to a target location. If the current location is within the proximity to the target location, then information is transmitted to the wireless device on offerings available at the target location.

In such a system, there is clearly no need (and no teaching) of storing locations in the device itself. The Office Action (first full paragraph, Page 3) points to various sections of Brown that allegedly teach the “saving, in the terminal” feature of claim 1. However, each of these sections relate to saving of location information at the PIM database. As described at col. 5, lines, 11-19:

The server 4 [emphasis added] includes a PIM database 22 maintaining user PIM information and a PIM server 24 for gathering and filtering data from wireless devices 2 for the users of the system. The PIM database 22 may be implemented using any database technology known in the art, e.g., relational database, object oriented database, etc. Although FIG. 1 only shows one wireless devices 2, the server 4 and PIM database 22 may maintain data for multiple wireless devices 2 and users.

Brown fails to teach or suggest the feature of claim 1 where location information is stored in the device itself.

The Office Action further states that the feature of “the recommender system is arranged for proposing content related to said region if the length of time is longer than a predetermined period” is taught by claim 13 and Col. 10, lines 26-30 of Brown. Claim 13 of Brown relates to a “wait time” for an event (i.e., the time one needs to spend in line waiting for admittance). Moreover, this “wait time” is determined by a history of **other** users (see, e.g., col. 14, lines 41-48). This teaching is clearly distinguishable from the language of claim 1 where the claimed feature “the length of time is longer than a predetermined time period” relates solely to the user’s device. The “wait time” addressed in Brown’s claim 13 is not related to the duration of a user at a location.

Col. 10, lines 26-30 of Brown does recite the use of a “filtered position record 60 which indicates a time period during which a user was at a location.” However, Brown immediately goes on to state that: “The filtered position records 60 are then stored (at block 324) in the PIM database 22 for later use” (Col. 10, lines 31-32). Here again, Brown fails to teach or suggest the feature of claim 1 where location information is stored in the device itself.

Further, the Office Action notes that “Brown may not teach explicitly that the recommender system is of a consumer electronic device” (page 3, last full paragraph). Mettu is then introduced to address this claim feature. The Office Action asserts that Mettu “discloses an apparatus and a method wherein a user accesses recommended content, location aware content, or filter-out content in accordance with **user location** [emphasis added] ... (See [0052] lines 1-4)” (page 3, last full paragraph). However, as described in [0052] it is the location of the user’s set top box (STB) 108 (i.e., the viewer’s location) that is used in determining the location aware content.

In Mettu, there is no mobile terminal involved, nor any “mobility” whatsoever. As described in paragraph [0034], the location of the STB is determined based on various user inputs (e.g., user’s billing address). Further, Mettu, like Brown, fails to teach or suggest the feature of claim 1 where location information is stored in the mobile terminal itself.

Applicant respectfully submits that the combination of Brown and Mettu fails to teach the features of claim 1, to include a consumer device's recommender system being informed by a mobile terminal of data pertaining to the device's location and duration at that location, the data having being determined and saved by the mobile terminal; and the recommender system proposing content related to said region if the length of time is longer than a predetermined time period.

Accordingly, Applicant submits that the combination of Brown and Mettu fails to teach the elements of claim 1, contrary to the assertions of the Office Action. Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner's rejections of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claim 1. Independent claim 10 recites features similar to those of claim 1 and is deemed patentable for at least the same reasons.

Further, Applicant submits that the combination of Brown and Mettu cannot sustain a §103 obviousness rejection as there is no motivation to combine these teachings. In order to establish a prima facie case of obviousness, generally three basic criteria must be met:

1. there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and

3. the prior art reference must teach or suggest all the claim limitations. The **teaching or suggestion** to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck* (citation omitted).(emphasis added).

However, in addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) reaffirmed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (citation omitted). The Court stated that "it can be important to identify a reason that would have prompted a person ...to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known. (citation omitted). The Court further addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a "helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM test is not to be applied in a rigid manner. Rather, the Court favored a more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements. Hence, the Court upheld precedent that "when prior art references require a selected combination to render obvious, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest

the desirability and, thus, the obviousness, of making the combination." Uniroyal Inc. v. Rudkin-Wiley Corp., (citation omitted).

Mettu relates to determining the location of a set top box and providing content based on that determination. There is no mobile terminal in Mettu whose position changes and which changed position(s) results in changed content from a recommender system. Brown relates to storing at a server, information related to the location of a remote device of a user. What aspect of Brown relates to a STB and viewer content based on its (fixed) location? In short, why would anyone think to combine the different devices of Brown and Mettu, other than to follow the blueprint of the claimed invention?

In addressing the obviousness rejection under 35 USC §103, the *KSR* Court did not diminish the requirement of objective evidence of obviousness. Rejections on the grounds of obviousness cannot be sustained by mere conclusory statements as there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In this case, the Examiner has selected elements from different prior art references to find elements recited in the claims. However, other than the conclusory statement that it would be obvious to incorporate the teachings of Mettu into the teachings of Brown, the Office has failed to provide any objective teaching or motivation to modify the Brown reference to properly address the claim features.

Accordingly, with regard to the subject matter recited in claims 1 and 10, Applicant respectfully submits that pursuant to an expansive interpretation of the three basic criteria necessary to show obviousness, a *prima facie* case of obviousness has not been set forth because the combination of the cited references has been impermissibly selected using the teachings of the instant application as a blueprint without any suggestion or reason for such combination.

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn. Independent claim 10 recites similar features and is deemed patentable for at least the same reasons.

Claims 2-9 and 11-19 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn. Since each dependent claim is also deemed to

define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

With respect to new claim 20, Applicant wishes to point out that Claim 20 is analogous to claim 1. However, this new claim recites that one or more past locations of the mobile terminal are being presented to the recommender system. Support for this feature is found, inter alia, at paragraph [0003] of the published application. Thus, claim 20 not only essentially emphasizes the feature of claim 1 that location information is being stored in the mobile terminal, but further distinguishes itself from the real time communication that is required in the teachings of Brown and other cited prior art.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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